

REMARKS

An Office Action was mailed on July 17, 2003. Claims 1-18 are pending in the present application. Claims 8-18 are currently withdrawn from consideration.

INFORMATION DISCLOSURE STATEMENT

Applicant is submitting an Information Disclosure Statement for the review and consideration of the Examiner.

PRIORITY DOCUMENT

Applicant is submitting herewith a certified copy of German Patent Application 199 07 940.4, filed February 24, 1999, from which priority was claimed in the present application under 35 U.S.C. §119.

REJECTIONS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claim 7 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Responsive thereto, Applicant has amended claim 7 to recite that the plastic coating is -- imprinted after extrusion onto the carrier material -- as set forth on page 8, lines 3-15 of the specification.

Accordingly, it is respectfully requested that the Examiner withdraw the rejection under 35 U.S.C. § 112, second paragraph.

EXAMINER'S COMMENT

The Examiner set forth her interpretation of "laser-active pigments" on page 3 of the Detailed Action. Responsive thereto, Applicant has amended the claims to more particularly set forth the intended definition of "laser-active pigments." The Examiner is directed to page 2, lines 13-15 of the specification for support for the claim amendments (*Further layers can, for example, be doped with materials which permit the plastic material to be personalized by means of a laser (CO₂, Nd:YAG)*). The doping materials are pigments which become colored, mostly

black, after laser exposure. Hence, it is possible to “write” data into a security document after manufacturing of the document. This process is often called “personalization”, because the personalized data of the owner of the security document are added. A further description of the inventive process can be found for instance on page 5, lines 22- 24 of the specification.

REJECTIONS UNDER 35 U.S.C. § 102

Claims 1-5 and 7 are rejected under 35 U.S.C. §102(b) as being anticipated by Hardwick et al. (WO 98/56596), while claims 1, 2, 4, 6 and 7 are rejected under 35 U.S.C. §102(b) as being anticipated by Merkle et al. (U.S. Patent 5,298,922).

Responsive thereto, Applicant has amended claims 1-7 to clearly distinguish the present invention from the cited. Applicant also respectfully submits that the structural construction (i.e. an extrusion) derived from the claimed extrusion process element results in a patentably distinct product as compared with the products of the prior art.

Hardwick et al. describes a multilayer product consisting of a polymeric film 9 which is coated on both sides with an opacifying pigmentary coating 10 and 11 and a protective coating 12 and 13. The opacifying pigments are not pigments in the sense of the claims as currently amended and as set forth in the specification (see description above relating to the Examiner’s Comments). Also, Hardwick does not describe by which method the layers are coated. Producing a multi-layer security document as an extrusion per se with thin, firmly connected and extruded layers is an essential, if not critical aspect of the present invention.

Normally, additional layers of security documents are laminated on the carrier material. In the lamination process the additional layer and the carrier material are connected using pressure and enhanced temperature, wherein the additional layer is softened. In contrast during extrusion, an additional layer is coated on the carrier material by applying a melt of the additional layer to the carrier material. Hence, the connection of the carrier material and the additional layer is stronger and more secure against counterfeiting than the connection of laminated layers. Often, dependent on the type of the carrier material, the melt even partly penetrates into the carrier material. Therefore the claimed product evidently differs substantially from those mentioned in the prior art.

The claimed invention addresses the problem of making available a multilayer security product that can be subsequently personalized (additional security features being able to be introduced or applied) and thereby satisfying the high security standards placed on such products. See pages 2 and 5 of the specification. Although the prior art discloses a laser-active arrangement of individual layers as set forth in U.S. Patent 4,507,346, for example, cited in the IDS submitted herewith, the prior art in general fails to teach or reasonably suggest the invention as currently claimed.

Application of the laser-doped layer by means of extrusion gives rise to relatively thin-gauge layers, which hinders subsequent manipulation of the security product. In addition, extrusion simplifies the manipulation of the structure of the doped synthetic layer, e.g., by extrusion of strips of varying composition or by successively superimposing several thin layers of varying sensitivity on top of each other. In prior art, laminate-based systems, laser-active components are interspersed as intermediate films into the layer structure. Such an approach can be extremely costly and gives rise to a thicker layer structure than does the present invention, which simplifies manipulation of the security products. The simple extrusion of a laser-sensitive synthetic layer is not taught or suggested by the prior art. Consequently, the multi-layer security product of claim 1 as amended is substantially simpler to produce than those shown in laminate-based security products, while also being more secure against forgery.

Merkle et al. describes an multilayer security document containing a base layer 1 and a first color layer 3 and a second color layer 2 that absorbs light. The absorption of light leads to the break down of the second color layer and the visibility of the first color layer in contrast to the lacking second color layer at the place of the laser application. This is close to the definition of "laser-active" in the patent application. However, such a disclosure fails to teach the claim element required in claims 1-7: *said at least one plastic coating being firmly extruded onto the carrier material to form a thin-gauged combination of layers and containing laser-active pigments that are doped to permit printing personalization by a laser such that said pigments become colored after laser exposure*. While the originally-filed claims may have been broadly interpreted by the Examiner to encompass the disclosure of Merkle et al., it is respectfully

submitted that the claimed invention as currently set forth is much narrower and goes beyond the teaching of the cited art including Merkle.

Accordingly, Applicant respectfully disagrees with the Examiner that the claims as amended are taught by the cited art. The Manual For Patenting Examining Procedure (MPEP) § 2131 clearly sets forth the standard for rejecting a claim under 35 U.S.C. § 102(b). “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” (MPEP § 2131, quoting Verdegaal Bros. v. Union Oil Co. of California 2 USPQ2d 1051, 1053 (Fed Cir. 1987)). “The identical invention must be shown in as complete detail as is contained in the ...claim.” (MPEP § 2131, quoting Richardson v. Suzuki Motor Co., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). “The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e. identity of terminology is not required.” (MPEP § 2131, citing In re Bond, 15 USPQ2d 1566 (Fed. Cir. 1990)).

In this case, the cited art fails to teach the claimed invention as required by the MPEP for the reasons discussed above. Specifically, the prior art fails to disclose a multi-layer security product, comprising an extrusion defined by a carrier material firmly joined to at least one plastic coating; said at least one plastic coating being firmly extruded onto the carrier material to form a thin-gauged combination of layers and containing laser-active pigments that are doped to permit printing personalization by a laser such that said pigments become colored after laser exposure; and at least one covering film laminated onto the carrier material, as currently claimed. It is also respectfully submitted that the product set forth in claims 1-7 incorporates structure that is neither disclosed nor suggested in the prior art, such structure being defined as an extrusion (noun) which defines the product itself and inherently a method of production, although the defined extrusion sufficiently defines the product over the recitations of the cited art, independent of the claimed extrusion requirement that is directly responsible for such structure. Hardwick et al. and Merkle et al. simply fail to teach or reasonably suggest an extrusion and the totality of the product as currently claimed.

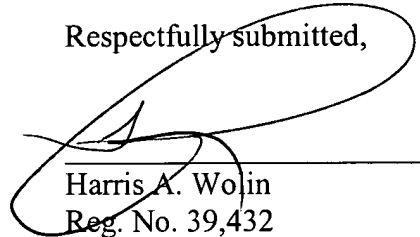
Accordingly, it is respectfully requested that the Examiner withdraw the rejections under 35 U.S.C. § 102(b).

For the foregoing reasons, reconsideration is respectfully requested.

An earnest effort has been made to be fully responsive to the Examiner's objections. In view of the above amendments and remarks, it is believed that claims 1-7, consisting of independent claim 1 and the claims dependent therefrom, are in condition for allowance. Passage of this case to allowance is earnestly solicited. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

Any fee due with this paper may be charged on Deposit Account 50-1290.

Respectfully submitted,



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